

**REMARKS/ARGUMENTS**

***Claim Rejections - 35 USC § 102***

1. The Examiner rejected claims 1 and 3-11 under §102(b) as being anticipated by Emmert.
2. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
3. The Examiner notes that “Emmert discloses the claimed invention an engineered lumber stud...”
4. Applicant respectfully disagrees. Emmert does not show a stud, it shows a wall panel. The differences are substantial. A stud is a component in a wall panel. The present invention is an apparatus for making a wall panel using a number of engineered studs (these studs being claimed in claims 1, 3-9, and a wall made using said studs is claimed in claims 10-11). The fact that such structure is used in a stud (an internal wall component) itself is novel and non-obvious.
5. Thus, Emmert does not disclose all of the elements of claims 1, 3-11.
6. Futhermore, the Examiner states that the Emmert shows the “stud defines a channel (38) defined by said first skin piece (14), said second skin piece (16) and said foam core piece (12); said channel (38) configured to receive at least one spacer (40) configured for attachment to at least one bottom plate (64) and top plate (66)...”
7. Applicant respectfully disagrees. Emmert’s channel (38) is a side channel, not a channel configured to receive at least one spacer configured for attachment to at least one bottom plate and top plate. Emmert does not show this structure and as such it is impossible for Emmert to accomplish what the Examiner mentions.
8. Futhermore, the structure that the Examiner points out in Emmert as being a “spacer (40)” is not a spacer, but is a spline for attaching adjacent panels together (see Fig. 4).
9. Further (presumably referring to independent claim 10), the Examiner points out that Emmert shows “a wall panel (figure 7) comprising: a plurality of spatially positioned, generally

parallel engineered lumber studs (10), at least one top plate (66) attached to a top portion of each of said studs; and at least one bottom plate (64) attached to a top portion of each of said studs, wherein said studs, said top plate and said bottom plate cooperate to form said wall panel (figure 7); each of said studs defines a first channel (attached figure 2) within said top portion of said stud, said first channel defined by said first skin (14)...”

10. Emmert does not disclose such structure. Emmert does not disclose studs, it discloses a wall panel comprising a sandwich of plastic foam and panel stiffeners.

11. As such, Applicant believes that claims 1, 3-11 are novel.

12. Additionally, the elements of claim 12 have been added to claim 10. The Examiner previously indicated that such a claim would be allowable. As such, for this additional reason claims 10 and 11 are allowable (claim 12 was thus cancelled).

### ***Claim Rejections - 35 USC § 103***

13. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

**A. The Examiner rejected claim 2 under §103(a) as being unpatentable (obvious) in view of Emmert.**

14. With respect to claim 2, the Examiner essentially argues that “it would have been an obvious matter of design choice to provide the depth being greater than the width, since such a modification would have involved a mere change in the size of a component.”

15. Applicant respectfully disagrees. The prior art reference (Emmert) does not teach or suggest all the claim limitations for a number of reasons. First, Emmert does not show an “engineered lumber stud.” Second, Emmert does not disclose the foam core piece depth being greater than said width.

16. The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

17. The Examiner suggests that the present invention is merely a version of Emmert where Emmert’s configuration is changed so that the depth is greater than the width. However, this is not the case in that Emmert teaches directly away from the concept. Emmert teaches a wall. A wall by its nature always has a width greater than its depth. Thus Emmert teaches that width is greater than depth.

18. The present invention goes the other way, teaching that depth is greater than width. This isn’t a design choice it is the core of the invention...making engineered studs and walls from said studs. Studs are deeper than they are wide. In example, consider a 2”x4” piece of dimensional lumber (a “stud”). The width (2”) is smaller than the depth (4”).

19. To take the Examiner’s position literally you have to assume that Emmert foresaw making a wall out of a number of studs having a depth greater than width placed side by side thereby creating a wall where the width is greater than depth. This is not the case an illustrates how Emmert teaches away from the present invention.

20. The Examiner must prove motivation to modify the prior art. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”), see also *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”). The Examiner has shown no proof within Emmert itself of such a motivation.

21. Even if such proof was there, in no way is it objective evidence providing motivation to modify the prior art.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references ...” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusionary statements regarding the teaching of multiple references, standing alone, are not “evidence.”

*In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

22. There is no motivation whatsoever provided by Emmert to provide an engineered stud where the width is less than the depth, and as such the present invention is non-obvious.

**B. The Examiner rejected claims 13-16 as being unpatentable over Emmert in view of Nixon.**

23. Examiner argues that Emmert shows a wall panel and Nixon shows cutting the panel into studs.

24. Applicant respectfully disagrees.

25. First, as argued above, Emmert does show a stud and teaches away from studs.

26. Second, Nixon does not show the creation of studs through cutting through a panel. Nixon shows taking a panel and cutting holes therein.

27. Thus, at most Emmert + Nixon discloses taking a panel and cutting window (or other) holes in it. That is not what is being done in the present invention where the panel is cut into a number of studs.

28. Finally, claim 13 (claims 14-16 depend there-from) has been amended to clarify this process, adding limitations that the panel body have a first end extending to a second end thereby defining a length and that a plurality of cuts are made from the first end to the second end (not just holes therein). Such changes further clarify said claims over the references cited.

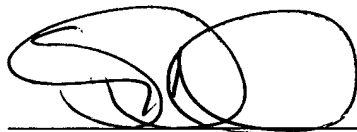
*Conclusion*

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 16<sup>th</sup> day of March 2005.

Very respectfully,



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